

Application Number: 09/993,751  
Amendment Dated: October 26, 2004  
Reply to Office Action of September 1, 2004

### Remarks

Claims 1-15, 35-41 are currently pending in the application. Claims 5, 8, 35-40 have been amended. Claim 41 has been added. No new matter has been added by way of amendment. Applicants respectfully request reconsideration of the claims in view of the following remarks.

The allowance of claims 1, 2, 4, 6, 7 and 9-15 is noted with appreciation.

Claims 5, 36, 38 and 40 are objected to because of formalities.

Claim 5 has been amended to recite "The plant part" as suggested by the Examiner.

Claims 36, 38 and 40 have been amended to recite "The progeny plant" consistent with antecedent basis.

### 112 Written Description Requirement

Claim 8 remains rejected and claims 3 and 35-40 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The Examiner states that the claims contain subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

The Examiner cites US Pat. No. 5,850,009 for the premise that progeny of a breeding cross produces new genotypes that are neither predictable nor incremental in value.

Claim 8 has been amended to require that the second Brassica plant is a *Brassica napus* plant. It is respectfully submitted that one skilled in the art can readily use the methods of amended claim 8 and new claim 41 to produce and select for progeny with the desired combination of traits. Applicants have provided sufficient written description by means of disclosure in the specification of breeding

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methods, by disclosure of the breeding history of NS3213 and by a deposit of NS3213 seeds.

The Examiner also cites the Fed. Reg. 71427, 71428 (1999), comment No. 4, as further support for the 112 rejection stating that a method is not described if products used in the method are not described.

It is submitted that the Applicants have met this standard. The first "product used" (the first *Brassica* plant) having the claimed traits has been fully described in the specification by a description of breeding methods, by disclosure of the breeding history of NS3213 and by a deposit of NS3213 seeds.

The second "product used" (the second *Brassica* plant) has been amended to require a *Brassica napus* plant. Any *Brassica napus* plant is suitable. Therefore, claim 8 fully meets the written description requirement.

The Examiner states that claim 3 lacks adequate written description because the claim is directed to somoclonal variants of the exemplified NS3213 *Brassica napus* plant produced from a tissue culture. The Examiner further states that Applicant does not describe somoclonal variants of the exemplified NS3213 *Brassica napus* plant produced from a tissue culture, neither in their structure or their function.

The rejection is respectfully traversed.

Claim 3 requires "A *Brassica* plant having an "R" rating for blackleg and resistance to at least one AHAS-inhibitor herbicide". The plant is regenerated from the tissue culture of variety NS3213. Claim 3 requires the significant properties of the claimed invention which are readily identifiable by routine testing and selection.

Applicants have provided a seed deposit of variety NS3213 having the required traits of claim 3. Applicants have also provided a breeding history for the development of variety NS3213. The information provides adequate structure and function. One of skill in the art can readily produce the plant of claim 3 having the claimed structure and function.

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It is respectfully submitted that it is not necessary to require that the plant of claim 3 "have all of the morphological and physiological characteristics of *Brassica napus* plant variety NS3213". Nature can hardly be more precise than to produce a clone of a plant from a parent cell.

The Examiner rejects claims 35-40 for lack of adequate written description because they are directed to any *Brassica* progeny of the exemplified NS3213 *Brassica napus* plant.

Claims 35-40 have been amended to require that the progeny are *Brassica napus*.

The Examiner indicates that one of skill in the art cannot describe progeny of a breeding cross because the progeny are not incremental in value.

The rejection is not understood. Is the Examiner saying that the incremental value is relative to previous claims or to prior *Brassica napus* plants? Claims 35-40 definitely provide an incremental value over prior *Brassica napus* plants which do not exhibit the combination of having an "R" rating for blackleg and resistance to at least one AHAS-inhibitor herbicide.

Applicant is not aware of case law or reference in the MPEP, 37 CFR or 35 USC to incremental value and a relationship to written description. If the Examiner maintains the rejection, clarification is requested.

The Examiner also states that the characteristics of an "R" rating for blackleg and resistance to at least one AHAS-inhibitor herbicide do not adequately distinguish the claimed progeny plant from others based on structure and functional characteristics by which one of skill in the art would recognize the Applicant was in possession of the invention as broadly claimed.

As noted above claims 35-40 are amended to require *Brassica napus* progeny. The amended claims call for *Brassica napus* progeny of variety NS3213 having the required traits described above. In order for progeny to meet the claims, there must be sufficient structure (genetics) from variety NS3213 to supply the traits.

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One of skill in the art can readily recognize that Applicant was in possession of the invention as claimed.

### 112 Enablement Requirement

Claim 8 remains rejected and claims 3 and 35-40 are rejected under 35 USC 112, first paragraph, as failing to comply with the enablement requirement. The Examiner states that the claims contain subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The rejection is repeated for the reason of record as set forth in the Office Action mailed Jan. 16, 2004, as directed to claim 8.

With regard to claim 8, the Examiner found Applicants' previous arguments unpersuasive because commercial traits are standards used by one of skill in the art to determine how to make and use a Brassica plant. The Examiner goes on to state that commercial viability is not a standard of patentability.

The rejection is not understood. If the Examiner maintains the rejection, clarification is requested.

The Examiner also objects to the scope of the source of the "second *Brassica* plant".

Claim 8 has been amended to require that the "second *Brassica* plant" is a "*Brassica napus* plant".

With regard to claims 35-40, the Examiner states that inheritance of blackleg resistance is not predictable as discussed in the previous Office Action as taught by Pang (1996). The Examiner further states that it is the Applicant's burden to teach one of skill in the art how to make and use the invention without undue trial and error experimentation. The Examiner concludes that Applicant does not teach what resistance loci for blackleg resistance the exemplified NS3213 *Brassica napus* plant comprises, or how these resistance loci will segregate in progeny plants.

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Claims 35-40 have been amended to require *Brassica napus* progeny. It is respectfully submitted that it is not necessary to "genotype" breeding lines in order to produce a successful product in a breeding program. Resistant plants are selected on a phenotypic basis. Applicants have provided a discussion of breeding methods known to those skilled in the art as well as suitable methods for selecting the desired plants. The method for selecting plants resistant to blackleg is found on pages 4-5 of the present application and set out below for the Examiner's convenience.

The Western Canadian Canola / Rapeseed Recommending Committee (WCC/RRC) is a government mandated organization that evaluates canola varieties in Canada and recommends varieties that meet certain criteria for registration by the Canadian Food Inspection Agency. The WCC/RRC uses a classification system to indicate the degree of resistance of canola varieties to blackleg infection. Varieties being tested are compared to the susceptible check variety, Westar, in an inoculated, approved disease screening trial. Testing procedures are set out in a document entitled "Procedures of the Western Canada Canola / Rapeseed Recommending Committee Incorporated for the Evaluation and Recommendation for Registration of Canola / Rapeseed Candidate Cultivars in Western Canada" which is available from the Canola Council of Canada. Canola varieties are placed in one of the following categories, based on a comparison of their disease score with the Westar check variety disease score, as set out below:

Disease Score*	Rating Classification
> 90	Highly susceptible
70 to 90	Susceptible
50 to 70	Moderately susceptible
30 to 50	Moderately resistant
< 30	Resistant ("R")

\* Expressed as a percentage of the  
Westar  
check variety disease score.

The Examples further provide a description of the use of an inoculum to select for blackleg resistant plants. See pages 19 and 27 of the present application. Basically plants are inoculated and the results are compared to a check variety. Selection is made for resistant plants.

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Methods of selecting plants having resistance to an AHAS-inhibitor are described throughout the Examples, see pages 16, 18, 20, 26, 27 and 28 of the present application. Plants are sprayed with an AHAS-inhibitor and compared to a check variety. Resistant plants are selected.

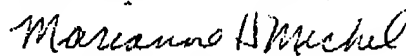
One skilled in the art does not need to know specifically which alleles are present at which resistance genes in individual lines. One must only select for resistant plants.

As noted in previous responses, the test for enablement is not whether experimentation is necessary, but rather if experimentation is necessary, whether it is undue. *In re Angstadt*, 198 USPQ 214, 219 (C.C.P.A. 1976). A considerable amount of experimentation is permissible if it is merely routine, or if the specification provides a reasonable amount of guidance in which the experimentation should proceed.

In the present case, the experimentation required is routine and has been well described in the specification. The specification also provides working examples of the invention. The skill in the art is high and the claims are commensurate in scope with the disclosure in the specification and the deposit.

In view of the amendments and comments above, reconsideration and allowance of the remaining claims is respectfully requested.

Respectfully submitted,



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